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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,585	03/18/2004	Kathleen Nylund Jackson	47079-00299USPT	7261

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NIXON PEABODY LLP  
300 S. Riverside Plaza  
16th Floor  
CHICAGO, IL 60606

EXAMINER
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HU, KANG

ART UNIT	PAPER NUMBER
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3715

MAIL DATE	DELIVERY MODE
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08/04/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/804,585	<b>Applicant(s)</b> JACKSON, KATHLEEN NYLUND	
	<b>Examiner</b> KANG HU	<b>Art Unit</b> 3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10, 15-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 15-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 3715

**DETAILED ACTION**

In view of the appeal brief filed on 4/29/2009, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3715

After careful consideration of comments and arguments provided in applicant's appeal brief dated 4/29/2009, the examiner is withdrawing the finality of the final rejection dated 12/1/2008.

Claims 9, 11-14, and 22 were previously cancelled; claims 1-8, 10, 15-21 and 23-28 are currently pending in the application.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-8, 10, 15-21 and 23-28 are rejected under USC 101, the claimed invention is directed to non-statutory subject matter. In order for a claimed process to be considered statutory it must be: (1) tied to a particular machine or apparatus, or (2) transform a particular article into a different state or thing. The use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility; the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity; and the transformation must be central to the purpose of the claimed process. Claims 1 and 21 as recited do not act upon a physical object so as to provide a transformation of that object into a different state or thing. Further the claims do not recite a tie to a particular machine or apparatus. The recitation of "playing a gaming system" in the preamble of the claims have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Dependent claims 2-8, 10, 15-20, and 23-28 are similarly rejected. Though some of these claims recite machines (i.e. claims 3, 4, 24 and 25: slot type wagering apparatus and networked wagering apparatus), the use of these machines does not

Art Unit: 3715

impose a meaningful limit on the claim's scope. Therefore claims 2-8, 10, 15-20 and 23-28 are also rejected for their dependency of claims 1 and 21 for failing to correct these deficiencies and therefore rejected for the same reason.

Additionally claim 1 recites “players playing an underlying wager game”, the claim encompasses a human being by positively reciting a player playing a game, the claimed invention is direct to nonstatutory subject matter per se.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-8, 16-21, 23-26, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Olsen (US 6,146,273).

Re claims 1 and 21, Olsen teaches a method of playing a gaming system played by a plurality of players where a jackpot is awarded, the method comprising:

players playing an underlying wagering game in which wagers are made by players (col 5, lines 1-2 and 16-22);

Art Unit: 3715

when an outcome occurs in the underlying wagering game that identifies that a jackpot is to be awarded to at least one of said players (col 7, lines 50-53), entering a special bonus event for all of said players presently playing the underlying wagering game (fig 4: 248 – start bonus mode; col 12, lines 20-25); the special bonus event providing a chance to be awarded bonus (col 8, lines 23-34);

randomly selecting bonuses to be awarded in the special bonus event (col 16, line 64 - col 17, line 27);

and randomly selecting more than one but less than all of said players to be awarded the randomly selected bonuses and excluding at least one player from being awarded any bonus (col 14, lines 8-10: random selector to provide the random selection of eligible gaming machines (and therefore eligible players ) to award bonus jackpots; col 15, lines 45-60: first and second bonus jackpot; col 16, lines 24-30: never selected to receive a bonus), said randomly selected bonuses being in addition to any awards some of said players may win during continued play of the underlying wagering game (col 17, lines 46-61).

Re claims 2 and 23, the underlying game is a casino table game (col 5, lines 1-5).

Re claims 3 and 24, the underlying game is played on a slot-type wagering apparatus (col 5, lines 1-5).

Re claims 4 and 25, the slot-type wagering apparatus is a networked wagering apparatus (col 5, lines 1-5).

Art Unit: 3715

Re claim 5, the jackpot is a progressive jackpot (col 5, line 39-40).

Re claims 6-8 and 26, the bonuses do not decrement the jackpot (col 24, lines 40-45).

Re claims 16-20 and 28, the bonus is selected from a group consisting of random bonus awards (col 17, table 1).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10, 15 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen (US 6,146,273) in view of Luciano Jr. et al. (US 6,887,154 B1).

Re claims 10, 15, and 27, Olsen does not teach of excluding the player who received the jackpot from being randomly awarded a bonus from the special bonus events. Luciano teaches of excluding the player who received the jackpot from being randomly awarded a bonus from a special bonus event (Luciano, col 4, lines 40-50);

At the time of the invention was made, it would have been obvious matter of design choice to a person of ordinary skill in the art to exclude the player who received the jackpot from being

Art Unit: 3715

randomly awarded a bonus from the special bonus event because applicant has not disclosed that excluding the player who received the jackpot from the special bonus provides an advantage, is being used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Olsen and applicant's invention, to perform equally well to include or exclude the person who has won the jackpot from being randomly awarded a bonus from a special bonus event because both would still allow the casino to randomly award bonuses to players who are currently playing to keep the player's interest in the game.

Therefore, it would have been prima facie obvious to modify Olsen to exclude the player who has won the jackpot from being randomly awarded a bonus from a special bonus event because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Olsen.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-8, 10, 15-21 and 23-28 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KANG HU whose telephone number is (571)270-1344. The examiner can normally be reached on 8-5 (Mon-Thu).



Art Unit: 3715

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-262-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kathleen Mosser/  
Primary Examiner, Art Unit 3715

/K. H./  
Examiner, Art Unit 3715